

### REMARKS

This responds to the Office Action mailed on September 19, 2005, and the references cited therewith. Claims 1-11, 17, 29-33 and 35-46 are now pending in this application. Applicants do not admit that the cited references are prior art and reserve the right to "swear behind" each of the cited references as provided under 37 C.F.R. 1.131.

#### §103 Rejection of the Claims

Claims 1-9, 17, 29-33, 35-43 and 45-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nahan et al. (U.S. 5,664,111) in view of Fisher et al. (U.S. 5,835,896).

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

Claims 1-9, 17, 29-33, 35-43, 45 and 46

Among the differences, claim 1 recites “communicating a variable price schedule for the item to the user.” For claim 17, among the differences, the claim recites “means for communicating a variable price schedule for the item to the user, the variable price schedule including a plurality of price selections for the item.” The Office Action indicated that this limitation is disclosed by Nahan at column 3, lines 1-10 and lines 31-67 and column 4, lines 46-61. Applicants respectfully disagree with assertion. None of these citations in Nahan disclose a variable price schedule.

In general, these citations in Nahan relates to viewing and purchasing works of art over a network. Specifically, Nahan at column 3, lines 1-10 relates to the use of monitors and printers to view works of art – “The System enables a member dealer to offer its customers a ‘virtual inventory,’ or access to the authorized works of art of every dealer on the Network.” Nahan at column 3, lines 6-9. Nahan at column 3, lines 31-67 relates to the use of the system by a “salesperson” to assist the customer in viewing different works of art over a network. This citation also relates to allowing a customer to reserve a work of art if the customer “has not firmly decided to purchase it.” Nahan at column 3, lines 57-58. Nahan at column 4, lines 46-61 relates to teleconferencing. “Thus, an ‘Opening’ in the gallery of one dealer can be broadcast simultaneously to galleries of other dealers with direct participation of the featured artist.” Nahan at column 4, lines 47-49. This citation also relates to “[t]he creation of a historical record of prices at which individual artwork or works of a particular artist are sold . . .” Nahan at

column 4, lines 54-55. Accordingly, this citation in Nahan discloses the sold price for individual works of art. It does not disclose a variable price schedule for an item.

Accordingly, because the cited references do not disclose or suggest all of the claim limitations, Applicants respectfully submit that the rejections of claims 1 and 17 under 35 U.S.C. §103 have been overcome. Additionally, because claims 2-9, 29-33, 45-43, 45 and 46 depend from and further define claim 1, Applicants respectfully submit that the rejections of claims 2-9, 29-33, 45-43, 45 and 46 under 35 U.S.C. §103 have been overcome.

#### Claim 8

Additionally, with regard to claim 8, among the differences, claim 8 recites “wherein acceptance of the reminder command in the receiving of a reminder command from the user is contingent on the receipt of contact information in a step of receiving contact information for the user, but wherein the presenting of the item is independent of the receipt of any contact information from the user.” The Office Action indicated that “[i]ncorporating this feature into Rackson et al and Fisher et al would have been obvious to a person of ordinary skill in the art so that the user can send a response indicating that the user agrees with a price.” Office Action at pages 3-4.

Applicants respectfully object to the taking of official notice, and pursuant to M.P.E.P. § 2144.03, Applicants traverse the assertion of official notice and requests that the Examiner cite a reference that teaches the missing elements. If the Examiner cannot cite a reference that teaches the missing elements, Applicants respectfully request that the Examiner provide an affidavit that describes how the missing elements are present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicants request withdrawal of the rejection and reconsideration and allowance of claim 8.

#### Claims 10-11 and 44

Claims 10-11 and 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nahan et al. in view of Fisher et al. and further in view of Godin et al. (U.S. 5,890,138). Applicants respectfully disagree with this rejection.

With regard to claim 10, among the differences, claim 10 recites “wherein the presenting of the item information includes presenting the plurality of price selections for the item including a plurality of time-separated price choices from a falling-price schedule.” The Office Action indicated that this limitation is disclosed by Godin at column 6, lines 50-56. Applicants respectfully disagree with this assertion. This citation in Godin relates to an auction where the prices of products decrease over time (assuming that products remain). However, this citation does not disclose that the schedule for the falling prices is presented to the user. Only that the price falls over time. Accordingly, the user does not know schedule of the times and associated falling prices.

With regard to claim 11, among the differences, claim 11 recites “displaying a present purchase control button next to the present price and a future purchase control button next to the future price.” The Office Action indicated that this limitation is disclosed by Godin at column 3, lines 48-53. Applicants respectfully disagrees with this assertion. This citation in Godin relates to a “time designation control” wherein not all products to be auctioned are displayed on a web site. Rather, these products are shown over time:

All products that are slated to be auctioned are not listed and browsers are encouraged to return to the web site on an ongoing basis to see what new products are to be auctioned in the near future.

Godin at column 3, lines 48-52.

However, this citation does not disclose a future purchase control button.

With regard to claim 44, among the differences, claim 44 recites “wherein the communicating of the variable price schedule includes displaying a future price and a future purchase control button next to it.” As described above in the discussion of claims 10-11, Godin does not disclose this limitation.

Accordingly, because the cited references do not disclose or suggest all of the claim limitations, Applicants respectfully submit that the rejections of claims 10-11 and 44 under 35 U.S.C. §103 have been overcome.

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 371-2103 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

JEFF CHIN ET AL.

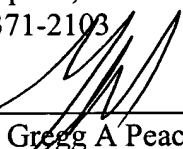
By their Representatives,

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Date

11-30-05

By

  
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 30 day of November, 2005.

Name

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Signature

